

Remarks:

In the Office Action, claims 1-10 were subject to a restriction requirement. Claims 1-6 were rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Pool et al., U.S. Patent No. 6,460,020 B1. Claims 7-9 were rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Pool et al. in view of Dutta et al., U.S. Patent Publication No. 2003/0061058 A1.

Applicants note with appreciation the Examiner's use of specific column and line references in the Office Action.

The above-described objections and rejections are addressed as follows:

A) AMENDMENTS TO THE SPECIFICATION

Applicants have amended the specification to recite previously unavailable serial numbers of applications that are otherwise identified in the specification. No new matter has been added by these amendments.

B) DISCLOSURE OF PENDING APPLICATIONS

Applicants note that the above-identified applications are directed to potentially related technologies, and might be considered relevant to patentability by the Examiner. In particular, these applications are:

US Patent Application, Serial No. 09/969,368, filed October 1, 2001;
PCT Patent Application, Serial No. US01/30696, filed October 1, 2001;
PCT Patent Application, Serial No. US01/30687, filed October 1, 2001;
PCT Patent Application, Serial No. US01/30702, filed October 1, 2001;
PCT Patent Application, Serial No. US01/30746, filed October 1, 2001;
PCT Patent Application, Serial No. US01/30747, filed October 1, 2001;
US Patent Application, Serial No. 09/969,369, filed October 1, 2001; and
US Patent Application, Serial No. 09/969,342, filed October 1, 2001.

C) RESTRICTION REQUIREMENT

Applicants affirm the election of claims 1-9, without traverse, in response to the
5 restriction requirement under 35 U.S.C. § 121.

D) REJECTIONS UNDER 35 U.S.C. § 103(a)

10 **1. The Cited Art Must Teach or Suggest All the Claim Limitations to Establish a *Prima Facie* Case of Obviousness**

To establish a *prima facie* case of obviousness, the prior art references, when
combined, must teach or suggest all the claim limitations. *See*, M.P.E.P. § 706.02(j).

15 **2. The Cited Art Fails to Teach or Suggest All the Claim Limitations Recited in Independent Claim 1**

20 Claim 1 now includes a minor amendment. In particular, the phrase “to the service level” has been amended to read “at a service level.” This amendment is not related to patentability, and is not intended to change the scope of the claim. No new search should be needed as the result of this amendment.

25 Independent claim 1 recites a method of conducting an international transaction in goods between a buyer and a seller. The method includes the action of “transmitting customs invoice information to a customs broker.” (emphasis added)

30 The Office Action recites that this step is disclosed by Pool, col. 11, lines 61-65, which states that “[i]n conventional transactions, when reaching the destination port, the international carrier official (such as the ship's captain) will turn over the commercial invoices to a commercial entity which specializes in moving the papers from the carrier to the customs department of the destination country.” (emphasis added)

35 As is noted in the present application, a financial (i.e., commercial) invoice, as is included in shipping documents, is not a customs invoice. The customs invoice will

typically include financial invoice data from the financial invoice. *See*, pg. 30, lines. 15-18. However, customs invoices also include classification information, description information and/or assist information. Classification and description information can vary from country to country, and should be used consistently for each import in a given country. *See*, pg. 36, line. 19 to pg. 37, line. 14. Assist information (i.e., information regarding the buyer providing parts across country borders to the seller for the manufacture of goods), will typically be needed on customs invoices for proper customs calculations. *See*, pg. 18, lines. 15-21.

In the described embodiment, the service engine that generates customs invoice information provides classification information, such as from a Regulatory Classification System (*see*, pg. 40, line. 28 to pg. 41, line. 2), description information, assist information and/or other customs information specific to the buyer, the seller, and/or the goods, as required by the particular customs authorities.

Pool fails to disclose the action of transmitting customs invoice information to a customs broker.

3. The Cited Art Fails to Teach or Suggest All the Claim Limitations Recited in Dependent Claim 3

Dependent claim 3 previously recited the method of claim 1, wherein the step of transmitting the shipping instructions included reciting the total shipping cost. To further clarify this, Applicants have amended claim 3 to recite that “the step of transmitting the shipping instructions includes transmitting the total shipping cost, calculated in the step of querying a database of shipping information, to the carrier.” (emphasis added)

The Office Action recites that this step is disclosed by Pool, col. 7, lines 28-34, which states that the customer inputs the destination for purposes of calculating the cost of delivering the products to the destination.

Pool fails to disclose the action of transmitting the total shipping cost, calculated in the step of querying a database of shipping information, to the carrier.

4. The Cited Art Fails to Teach or Suggest All the Claim Limitations Recited in Dependent Claim 4

Dependent claim 4 previously recited the method of claim 1, wherein the step of transmitting a customs invoice includes reciting the total brokering cost. To further clarify this, Applicants have amended claim 4 to recite that “the step of transmitting customs invoice information includes transmitting the total brokering cost calculated in the step of querying a database of brokering information, to the broker.” (emphasis added)

The Office Action recites that this step is inherently disclosed by Pool. Applicants traverse the assertion that this step is inherent.

As recited in MPEP § 2112, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

The transmission of the total brokering cost to the broker is not necessary for the embodiment described in Pool. Pool fails to disclose, explicitly or inherently, the action of transmitting the total brokering cost to the broker.

5. The Claim Limitations Recited in Dependent Claim 5 Are Not Old and Well Known in the Art

Dependent claim 5 has now been clarified to recite the steps of receiving and tracking status updates regarding the status of the goods in transport to the buyer; and providing status reports summarizing the received status updates in response to status requests received regarding the status of the goods.

The Office Action included a statement that certain features are old and well known in the art. If it is now asserted that the claimed features, as clarified, are old and

well known in the art, Applicants traverse this assertion and request the assertion be supported with adequate evidence.

The features recited in claim 5 are not old or well known in the art.

6. The Office Action Fails to Establish a *Prima Facie* Case of Obviousness

For the reasons recited above, the cited art fails to teach or suggest the features explicitly recited in claims 1, 3, 4 or 5. Claims 2-9 depend, directly or indirectly, from claim 1. Therefore, the Office Action fails to establish a *prima facie* case of obviousness with respect to claims 1-9. Accordingly, the rejections of claims 1-9 under 37 U.S.C. § 103(a) are improper, and Applicants respectfully request they be withdrawn.

E) NEW CLAIMS

New claims 11-15 contain no new matter (*see*, e.g., pp. 11-13 of the specification), and recite new and nonobvious features of the invention. Applicants respectfully request claims 11-15 be allowed.

F) CONCLUSION

In light of Applicants' amendments and arguments, Applicants believe that the claims are now in condition for allowance. In view of the foregoing, Applicants respectfully request a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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